

REMARKS

Claims 1-20 and 22-35 are pending. Reconsideration is respectfully requested.

Claim Status

Claims 1-3, 5-7, 11, 13, 15-19, 22-28, 30, and 32-34 were rejected under 35 U.S.C. § 103(a) over Watari (US 2001/0003345) in view of Sawada (US 5,835,816) and Motomura (US 4,521,102).

Claims 4 and 20 were rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada, Motomura, and Howard (US 2002/0126849).

Claims 8-10, 12, and 14 were rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada, Motomura, and Graef (US 2002/0036159).

Claims 29 and 31 were rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada, Motomura, and Brannan (US 5,850,075).

Claim 35 was rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada, Motomura, and Fukuda (JP 2003/157,465).

Applicant requests that the premature final rejection be withdrawn

The Office can't make a new rejection (e.g., adding Motomura) against a non amended claim (e.g., claim 35), and then make that new rejection final. Yet this is the current situation. For example, the 35 U.S.C. § 103(a) rejection of claim 35 is new because it now additionally relies on Motomura. However, claim 35 was not amended in Applicant's response filed March 2, 2009. Thus, the final rejection of claim 35 is *prima facie* premature.

In order for the new 35 U.S.C. § 103(a) rejection of non amended claim 35 based on Watari/Sawada/Motomura/Fukuda to be legally proper, it must first be presented in a non final rejection. This situation has not yet occurred. The entire final rejection is premature. See MPEP § 706.07(a) and § 706.07(f)(III)(M). Also, MPEP § 706.07(e) makes clear that when a final rejection is withdrawn, all amendments (which includes the current amendment) filed before the withdrawal are entitled unhindered entry.

The references do not render the claims obvious

Applicant respectfully disagrees with the rejections. Applicant's remarks filed March 2, 2009 remain pertinent. Thus, they are herein incorporated by reference. Additional remarks follow.

Claim 1 is directed to generating a receipt events signal in response to the occurrence of *both*: sensing a failure to deliver a first transaction receipt from the machine *and* sensing a failure to deliver a sequential second transaction receipt from the machine while the first receipt still remains in the machine. The combination of references relied upon in the rejection does not teach or suggest the recited order or timing of claim. Similarly, the combination of references also does not teach or suggest the other claimed subject matter.

Watari is relied upon to teach an automated banking machine that can provide receipts. Sawada is relied upon to allegedly teach sensing a first paper jam in a copier machine in a first copying operation, and later (after the first paper jam was cleared) sensing a second paper jam in the machine in the next (second) copying operation. As best understood, Motomura is apparently relied upon to allegedly show an attempt to copy (with a copier machine) another paper in a next copying operation while a first paper jam (from a prior copying operation) still remains in the machine.

The Action (at page 3) alleges that Motomura teaches “delivering a second paper sequentially immediately after the first transaction, while the first paper remains in the machine”. The Office previously alleged (at page 19 of the Action dated December 2, 2008) that Motomura teaches “while the first receipt remains in the jammed condition in the machine, sending a second receipt in the receipt path toward the receipt outlet”.

The Applicant respectfully disagrees with the Office’s interpretation of the references (and the claim language). For example, paper copying “operation” with a copier machine relied upon in the rejection does not equate to a “transaction” with a cash dispensing automated banking machine. Nor would one of ordinary skill in the art of cash dispensing automated banking machines look to a paper copier machine to modify a cash dispensing automated banking machine.

For further example, the section (col. 5, lines 18-20) relied upon in Motomura has nothing to do with sending a second paper sheet *after* determining that a first paper sheet still remains jammed in the copier machine. Furthermore, the relied upon jam (of two paper sheets) in Motomura occurs in the *same* copying operation, not in *sequential* (and distinct) copying operations. Note the “second transaction conducted . . . sequentially immediately after the first transaction” of claim 1. Which of the references teaches that a jammed copier machine will let a new copying operation begin? Motomura doesn’t. Motomura conventionally teaches that jammed paper has to be manually removed before any copying is permitted (e.g., col. 1, lines 27-29; col. 2, lines 8-9 and 19-20; col. 3, lines 53-55; col. 6, lines 36-39). It follows that Motomura does *not* teach “delivering a second paper” in a second copying operation that is “sequentially immediately” after a first copying operation, “while the first paper remains in the machine” (from

the first copying operation), as alleged by the Office. Thus, Motomura cannot alleviate the deficiencies of the other references. It follows that the combined teachings of the references could not have resulted in the recited invention.

Nor would the combined teachings of the references result in (as apparently alleged by the Office) a jam signal that is produced after *both* a first jam sensing in a first copying operation *and* a second jam sensing in a later second copying operation during which the first jam still remains. None of the references teach or suggest detecting a (first) paper jam, then copying paper while the first jam remains, then detecting another (second) paper jam while the first jam remains, and then first generating a jam signal. Again, which of the references teaches (as apparently alleged by the Office) a paper copier machine that will let a new copying operation begin while a paper jam remains in the machine? Further, which of the references teaches a paper copier machine that doesn't generate a paper jam signal until after two different paper jams, each from a different copying operation, are sensed as being in the machine at the same time?

Sawada appears to relate to keeping track of the number of jams in a paper copier machine over time in order to enable prediction of future critical errors therein so as to allow a serviceman to service the machine before a predicted critical error actually occurs.

Motomura appears able to determine at the time of a paper jam in a paper copier machine, the difference in the number of sheets that had been fed into the machine minus the number of copies that had been discharged from the machine. This number difference, which is representative of sheets removed from the machine interior due to the paper jam, apparently can be used to adjust the feed counter so that the correct number of requested copies will be actually made (upon copying restart).

At best, combining Sawada and Motomura would have resulted in a paper copier machine that can (because of Sawada) have servicing based on predicted future critical errors therein, and can (because of Motomura) more accurately provide the correct number of copies requested by taking into consideration sheets removed because of a paper jam. At best, combining Watari and Sawada/Motomura would have resulted in an ATM that is spaced from a paper copier machine.

The Office has not established a *prima facie* case of obviousness. The record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have produced the recited invention. The rejections are based solely on attempted hindsight reconstruction of the claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness.

The declaration pursuant to 37 C.F.R. § 1.132

The 37 C.F.R. § 1.132 declaration filed March 6, 2009 was from a person with actual knowledge of the relevant art and level of ordinary skill in the art of cash dispensing automated banking machine operation at the time of the present invention. The declaration states that it would *not* have been obvious to the person having ordinary skill in the art, having full view of Watari, Sawada, and Motomura, to have produced the recited methods (or article). The declaration further establishes that the relied upon combination of references does *not* provide any teaching, suggestion, motivation, or valid reason to a person of ordinary skill in the art at the time of the present invention to have produced the recited invention.

It is well settled that "weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967). Applicant respectfully submits that the declaration provides such statement. Thus, Applicant respectfully submits that the Office give the declaration its proper weight.

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Request for an interview

Applicant respectfully requests an interview should the Examiner, after considering Applicant's above remarks, be of an opinion that any of the rejections should be maintained. Applicant seeks such an interview to better understand the Examiner's viewpoint and to find common ground regarding allowable subject matter. Please contact Applicant's representative at the phone number provided below to arrange the interview date and time, if necessary.

Conclusion

Applicant respectfully submits that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 Broadway
Medina, Ohio 44256
(330) 721-0000